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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,438	11/16/2000	Mehryar Khailili Garakani	2705-129	5707

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EXAMINER

LEZAK, ARRIENNE M

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/715,438	GARAKANI ET AL.	
	Examiner	Art Unit	
	Arrienne M. Lezak	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-16 & 18-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Applicant's submission filed on 14 February 2005 has been entered. Examiner notes that Claims 1, 8, 12, 15 & 19 have been substantively Amended, Claim 5 has been non-substantively Amended, Claims 4 & 17 have been previously cancelled and no Claims have been added. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 12 November 2004 as reiterated herein below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 8, 12, 15 & 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the specification does not teach, "performing

modem relay operations without further negotiation", as noted within the amended claims.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Thus, the claims as amended will not be read to include the language, "without further negotiation" for purposes of examination.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5, 8, 12 & 14-16 & 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent US 6,504,838 B1 to Kwan.

7. Regarding Newly Amended Claims 1, 8, 12, 15 and 19, Kwan discloses a method, apparatus and computer-readable medium for establishing a high-speed modem relay connection over a voice frame network between an originating modem with an associated calling-leg gateway and an answering modem with an associated called-leg gateway, (Col. 87, lines 1-22), the method comprising:

- first detecting a predefined modulated answer tone at a first (answering) voice frame network gateway corresponding with the answering modem, (Col. 66, lines 23 –67; Col. 67, lines 1-31; Col. 69, lines, 30-56; and Col. 87, lines 1-22);
- second detecting a predefined digital code at a second (calling) voice frame network gateway corresponding with the originating modem, (Col. 66, lines 23 –67; Col. 67, lines 1-31; Col. 69, lines, 30-56; and Col. 87, lines 1-22);
- suppressing signal transmission between the originating modem, (gateway) and the answering modem, (gateway), (per pending Claim 4), (Col. 67, lines 7-31);
- at the second (calling) gateway detecting two additional predefined digital codes from the originating modem and completing (calling) local physical layer negotiation, (Col. 66, lines 23 –67; Col. 67, lines 1-31; Col. 69, lines, 30-56; and Col. 87, lines 1-22);

- at the first (answering) gateway transmitting at least two additional predefined digital codes to the answering modem and completing (answering) local physical layer negotiation independently of the calling local physical layer negotiations, (Col. 66, lines 23 –67; Col. 67, lines 1-31; Col. 69, lines, 30-56; and Col. 87, lines 1-22); and
- enabling signal transmission between the originating modem and the answering modem, (Col. 67, lines 7-31);
- whereby the voice frame network connection is selectively automatically transitioned from voice mode to modem relay mode upon a determination that the originating and the answering modem are both high-speed modems, (Col. 10, lines 4-24; Col. 71, lines 54-67; Col. 72, lines 1-67; Col. 73, lines 1-51; and Col. 67, lines 7-31).

Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Newly Amended Claims 1, 8, 12, 15 and 19.

8. Regarding Claims 2, 3, 14, 16 and 20, Kwan discloses a method, apparatus and computer-readable medium for establishing a high-speed modem relay connection over a voice frame network wherein an amplitude-modulated answer (ANSam) tone is first detected at one of the gateways and a digital call menu (CM) is secondly detected at the other one of the gateways, (per pending Claims 2, 16 and 20), wherein the first gateway to perform said tone-detecting signaling to the other gateway that tone detection has occurred, (per pending Claims 3, 14 and 17), (Col. 69, lines 30-56).

Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 2, 3, 14, 16 and 20.

9. Regarding Claims 5 and 18, Kwan discloses a method, apparatus and computer-readable medium for establishing a high-speed modem relay connection over a voice frame network wherein negotiating includes: at the calling-leg gateway detecting two additional digital CM codes from the originating modem and completing local calling-leg physical layer negotiation, and at the called-leg gateway transmitting at least two additional digital CM codes to the answering modem and completing local called-leg physical layer negotiation, (Col. 69, lines 30-56 and Col. 72, lines 38-62). Therefore, this reference may reasonably be read to teach or describe every element or claim limitation of Claims 5 and 18.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6, 7, 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over further consideration of US Patent US 6,504,838 B1 to Kwan. Kwan is relied upon for those teachings disclosed herein. As noted above, Kwan discloses a method, apparatus and computer-readable medium for establishing a high-speed modem relay connection over a voice frame network inclusive of voice compression,

(Col. 8, lines 18-41), and echo cancellation, (Col. 10, lines 5-67). Kwan does not specifically disclose that after detecting the first tone and before detecting the second tone, enabled voice compression is disabled, (per pending Claims 6, 9, 11 and 13), and enabled echo cancellation is disabled, (per pending Claims 7, 10, 11 and 13), (Col. 8, lines 18-41 and Col. 10, lines 4-67).

12. To incorporate the disablement of voice compression and echo cancellation into Kwan's method, apparatus and computer-readable medium for establishing a high-speed modem relay connection over a voice frame would have been obvious to one of ordinary skill in the art at the time of invention by Applicant. The motivation to combine is noted by Examiner in that a handshake, (as noted within Kwan), is not an analog to digital conversion, thus there is no noise. Without noise, there is no need for voice compression and echo cancellation, which would only serve to drop bits. Moreover, such disablement functionality is applied within Kwan in regards to the data pump as related to the reception/transmission of messages or fax data signals, (Fig. 21 and Col. 55, lines 52-55). Therefore, Claims 6, 7, 9-11 and 13 are unpatentable over further consideration of the teachings of Kwan.

Response to Arguments

13. Applicant's arguments filed 23 July 2004, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections

made. Further, they do not show how reconsideration avoids such references or objections.

14. Regarding Applicant's assertion that Kwan does not teach signal suppression, Examiner respectfully disagrees citing Kwan, (Cols. 66-71 – particularly Col. 67, lines 7-31), which discloses a data rate negotiation procedure, which procedure includes automatic data suppression during the negotiation process. Examiner further notes that the rate negotiation procedure taught by Kwan inherently includes all modem speeds for purposes of rate matching and suppression as necessary. Moreover, as Applicant notes within the "remarks" section, (p. 8/10) of the Amendment dated 23 July 2004, Kwan teaches "one type of signal that indicates that the modems are high speed modems", it is clear that Kwan inherently detects high-speed modem signals, which signals, when processed during the rate negotiation procedure, would inherently be suppressed as necessary.

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Examiner finds that Kwan clearly teaches both voice compression, (Col. 8, lines 26-27), and echo cancellation, (Col. 10, lines 25), wherein use, (or disablement), of the same for any

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purpose would have been obvious for the creation of an efficient and robust integrated system for the exchange of voice, fax and modem data between telephony devices and packet based networks, (Col. 1, lines 60-63).

16. Additionally, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

17. Thus, as Examiner has completely addressed Applicant's amendment, and finding Applicant's arguments do not show how reconsideration avoids such references or objections, Examiner hereby maintains the original rejection of all claims in their entirety.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
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